

REMARKS

The Office Action dated September 3, 2003 has been carefully considered. First, Applicants acknowledge and appreciate the Examiner's decision to re-open prosecution upon review of the appeal brief filed on June 18, 2003.

Independent claim 1 has been amended to incorporate the subject matter of cancelled dependent claim 27, and to include subject matter found in the present specification at page 4, lines 10-12. Claim 2 has been amended to include a degree of substitution limitation disclosed in the specification at page 4, line 30- page 5, line 1. There is now 1 independent and 15 dependent claims for a total of 16 claims currently pending in this application.

It is believed that this amendment does not include new matter and that entry is therefore in order and should therefore be granted. The changes presented with this amendment, along with the following remarks, are believed sufficient to place all the claims of the present application in condition for allowance. Reconsideration is respectfully requested.

35 U.S.C. §102

Claims 1-3, 7-8, 9-11 and 31 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,306,435 to Ishikawa et al. ("Ishikawa"). Specifically, the Examiner asserts that Ishikawa teaches a treating composition comprising polymeric soil release agent carboxymethylcellulose ("CMC") and anionic, cationic and nonionic surfactants present in the amount of 1-20%. The Examiner further asserts that Ishikawa treating compositions comprise solubilizing and drying agents such as ethanol, and antimicrobial agents. The Examiner concludes that Ishikawa teaches all the limitations of the rejected claims which are therefore anticipated by the reference. This rejection is traversed and reconsideration is respectfully requested.

According to claim 1, the present inventive compositions are directed to pre-treating compositions for shoes comprising a polymeric soil release agent and a spreading agent. The polymeric soil release agent must be present *in an amount effective to provide soil release benefit*, wherein removal of soil from the shoes in washings subsequent to application of the pre-treating composition to the shoes is improved over removal of soil from the shoes in washings without application.

Ishikawa, on the other hand, is directed to the pre-treatment of raw leather, fur and pelts prior to their manufacture into downstream articles. The Ishikawa pretreatment is intended to decrease undesirable shrinkage of the natural fiber upon washing. Applicants respectfully submit that the Examiner's assertion of Ishikawa disclosing CMC as an ingredient of the Ishikawa treatment solution is in error. The Ishikawa disclosure contains over 90 exemplar formulations, none of which comprise CMC. In fact, none of the Ishikawa formulations comprise a polysaccharide of any species. The Examiner cites col. 4, line 48 of Ishikawa in support of the Examiner's position. This passage, however, teaches CMC as an emulsion stabilizer in a well-known method directed to producing the water-soluble and/or water-dispersable polyurethane constituting ingredient (a) of the Ishikawa compositions defined by Ishikawa claim 1 and depending claims 2-10. The presence of any of this CMC in the final Ishikawa compositions is simply not disclosed or inherent in the teachings of Ishikawa. Clearly, this does not meet the required limitation of instant claim 1 wherein "an amount effective to provide soil release benefit" is required (see specification p.7, lines 3-6 for definition of "effective").

Further, Applicants find no teaching or suggestion in Ishikawa to formulate compositions to pre-treat shoes such that removal of soil from the shoes in washings subsequent to application of the pre-treating composition to the shoes is improved over removal of soil from the shoes in washings without application. In fact, Ishikawa teaches that

application of their compositions to natural fibers will cause them to expand by as much as 10%, making the Ishikawa compositions completely unsuitable for application to articles by consumers. Applicants therefore submit that the Ishikawa treatment compositions cannot meet the pre-treatment limitation of instant independent claim 1.

Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *In re Paulson*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed.Cir.1994). The corollary of the rule is that absence from the reference of any claimed element negates anticipation. *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed.Cir. 1986). "It is well settled that prior art under 35 U.S.C. § 102(b) must sufficiently describe the claimed invention to have placed the public in possession of it." *Elan Pharmaceuticals Inc. v. Mayo Foundation for Medical Education and Research*, 68 USPQ2d 1373 (Fed. Cir. 2003). Ishikawa fails to teach or disclose compositions comprising CMC in an amount effective to provide soil release benefit, as required by instant independent claim 1. Hence, Ishikawa does not anticipate either claim 1, or the claims depending therefrom. Ishikawa fails to teach or disclose compositions which would enhance the removal of soil from shoes after treatment. Simply put, the public would not be in the possession of the present invention even if they were in possession of the Ishikawa disclosure. Therefore, independent claim 1, and claims 2-3, 7-8, 9-11 and 31 depending therefrom, are novel and patentably distinct from the compositions of Ishikawa and the rejection under 35 U.S.C. §102(b) is overcome. Reconsideration is respectfully requested.

Claims 1-3, 7-11 and 31 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,767,563 to de Buzzaccarini ("Buzzaccarini"). Specifically, the Examiner asserts that Buzzaccarini teaches a liquid cleaning composition comprising the polymeric soil release agent carboxymethylcellulose, alkylated polysaccharides, from 1-20% nonionic surfactants as spreading agents, antimicrobial agents, and drying agents such as ethanol. The

Examiner concludes that Buzzaccarini teaches all the limitations and therefore anticipates the rejected claims. This rejection is traversed and reconsideration is respectfully requested.

The present invention, as defined by claim 1, is directed to pre-treating compositions for shoes comprising a polymeric soil release agent and a spreading agent. The polymeric soil release agent must be included in an amount effective to provide soil release benefit. In addition, removal of soil from the shoes in washings subsequent to application of the pre-treating composition to the shoes is improved over removal of soil from the shoes in cleanings without application of the pre-treating composition to the shoes.

Buzzaccarini, on the other hand, is directed to hard-surface scouring cleansers. The only disclosures of polysaccharides by Buzzaccarini is at column 4, lines 45-54 listing CMC as an optional "thickener", and at column 5, lines 10-13 suggesting the optional use of alkylated polysaccharides to increase stability and performance. In the paragraph discussing optional thickeners, Buzzaccarini discloses typical thickener concentrations as 0.01% or higher, "depending on the desires of the formulator." Clearly, since this sentence closes the discussion on thickeners, the "desires" of the formulator are as to the desired thickness of the composition, not generally or with respect to soil-release efficacy. None of the Buzzaccarini exemplar compositions comprise CMC in an amount effective to provide soil release benefit.

Moreover, instant claim 2, which is directed to the pre-treating compositions of claim 1 wherein the polymeric soil release agent is a polysaccharide, explicitly requires that the polysaccharide exhibit a degree of substitution ranging from about 0.6 to about 1.2. Degree of substitution is relevant to the physical characteristics of a given polysaccharide, by influencing, *inter alia*, viscosity, cross-linking and water-holding capacity. Applicants find no teaching or suggestion in Buzzaccarini limiting the degree of substitution of purported polysaccharide ingredients.

Further, Applicants find no teaching or suggestion in Buzzaccarini that the reference compositions enhance soil removal in washings when applied to shoes prior to the washings. Moreover, Applicants fail to find any teaching or suggestion in Buzzaccarini of compositions as taught by the present disclosure which would inherently provide this enhancement, since amounts, molecular weight, and degree of substitution are all undisclosed and left to happenstance.

Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *In re Paulson*, 30 F.3d at 1475. The corollary of the rule is that absence from the reference of any claimed element negates anticipation. *Kloster Speedsteel*, 793 F.2d at 1565. "It is well settled that prior art under 35 U.S.C. § 102(b) must sufficiently describe the claimed invention to have placed the public in possession of it." *Elan Pharmaceuticals*, 68 USPQ2d at 1373. Buzzaccarini fails to teach a soil-release agent as required by present independent claim 1, and fails to disclose compositions which, when applied to shoes prior to washing, enhance soil removal. Further, Buzzaccarini fails to disclose amount, molecular weight, or degree of substitution limitations for any polymeric agents purportedly taught. Hence, claims 1-3, 7-11 and 31 are novel and patently distinguished from Buzzaccarini and the rejection under 35 U.S.C. §102(b) has been overcome. Reconsideration is respectfully requested.

35 U.S.C. §103

Claims 4-6, 12 and 30 are further rejected under 35 U.S.C. §103(a) as being unpatentable over Ishikawa. Specifically, the Examiner asserts that Ishikawa teaches shoe treating compositions comprising polysaccharide carboxymethylcellulose, ethanolic solution of antimicrobial agent, and surfactants in the amount of 0.2 to 30%. The Examiner further asserts that the instant claims differ from the reference by reciting a treating composition

comprising a polysaccharide having molecular weights of less than about 1,000,000, 500,000 and 250,000 as claimed in claims 4-6. However, the Examiner concludes that it would have been obvious to one having ordinary skill in the art to make such a composition by incorporating polysaccharide compounds having an average molecular weight of less than 250,000 with a reasonable expectation of success, and would expect such a composition to have similar properties to those claimed. This rejection is traversed and reconsideration is respectfully requested.

The present inventive pre-treatment compositions have been fully described in the above arguments. While Applicants concede that IF Ishikawa included such polysaccharides, an argument that similar results may occur might be germane, Applicants find no suggestion or motivation in Ishikawa or the state-of-the-art at the time of the invention for such inclusion of a polysaccharide. In fact, the Ishikawa compositions do not specifically include ANY polysaccharides, and, as fully discussed supra, polysaccharides, specifically CMC, are only mentioned in Ishikawa as an optional ingredient to a well-known method for manufacturing one of the Ishikawa ingredients. It is NOT a substance contemplated or disclosed as an ingredient in the Ishikawa compositions per se, in any amount, or of any molecular weight. Since there is no teaching or suggestion in Ishikawa of the addition of polysaccharides or CMC to the Ishikawa compositions, there is certainly no suggestion or motivation for the inclusion of polysaccharides of a particular molecular weight range.

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art, *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). In order to render a claimed invention obvious, prior art must enable one skilled in the art to make and use the claimed invention, *Motorola, Inc. v. Interdigital Tech. Corp.*, 43 U.S.P.Q.2d 1481, 1489 (Fed. Cir. 1997). Since Ishikawa fails to teach or suggest the inclusion of polysaccharides or any polymeric soil release agent in

amounts effective to provide a soil release function, and fails to teach or suggest particular amounts or molecular weight ranges for polymeric soil release agents, Ishikawa does not obviate the present claims. Therefore, the rejection under §103 of dependent claims 4-6, 12 and 30 is per se overcome and reconsideration is respectfully requested.

Claims 12, 27-29 and 31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Buzzaccarini. Specifically, the Examiner asserts that Buzzaccarini teaches a cleaning composition comprising a polymeric soil release agent - CMC in the amount of 0.01% or higher depending on the "desires of the formulator," and surfactants as spreading agents in the amount of 2 to 8%, and an aqueous solution in ethanol of an antimicrobial agent. The Examiner further asserts that the instant claims differ from the reference by reciting polymeric soil release agent and spreading agent in optimal amounts, but contends that it would have been obvious to one having ordinary skill in the art to make the instant compositions with a reasonable expectation of success because the reference teaches that CMC may be present in the composition in the amount of 0.01% or higher depending on the desires of the formulator, and surfactants in a range overlapping with the instantly claimed range such that a person of ordinary skill in the art would be motivated to optimize the amount of CMC and spreading agent to get compositions with similar properties to those claimed. This rejection is traversed and reconsideration is respectfully requested.

The elements of instant claim 1 were completely discussed in arguments above. To reiterate, it was shown that Buzzaccarini fails to anticipate instant claim 1 because it fails to teach or suggest pre-treatment compositions comprising a polymeric soil release agent in an amount effective to provide soil release. Instant claim 28 discloses the broadest instantly claimed range of pre-treating compositions comprising from about 0.1 to about 95% polymeric soil release agent, while instant claim 29 discloses a range of from about 0.1 to about 10% of the polymeric soil release agent. Buzzaccarini, on the other hand, discusses

CMC, a polysaccharide disclosed presently as a polymeric soil release agent, only in the context of being an optional thickener. Buzzaccarini closes the paragraph discussing thickening agents in a "typical" amount of 0.01% or higher, depending on the desires of the formulator." Applicants submit that the "desires of the formulator" are based on thickening qualities desired, and would not provide sufficient motivation to include an amount ten times that disclosed. Buzzaccarini fails to disclose any exemplar compositions comprising CMC in any amount.

Obviousness must be construed in light of the problem facing the inventor. *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ 2d 1321 (Fed. Cir. 1990). Since Buzzaccarini seeks to find optimal amounts of thickening agent, while Applicants seek to find optimal amounts of soil release agent, it cannot be said that an ordinary practitioner in the arts would have a reasonable likelihood of success in formulating a composition directed to the latter, by reference to a disclosure directed to the former, particularly given that the amount disclosed by Buzzaccarini as "typical" differs from the presently disclosed amounts by a full order of magnitude.

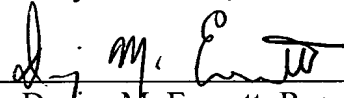
"[T]he Examiner has some burden to show some teaching or suggestion in references and to support their use in the particular claimed combinations." *Smith-Kline Diagnostics, Inc. v. Helena Laboratories, Corp.*, 8 U.S.P.Q.2d 1468, 1475 (Fed. Cir. 1988) There is no explicit motivation in Buzzaccarini to modify the teachings to enable the present inventive compositions. Further, Buzzaccarini is directed to scouring cleansers for hard surfaces while the present invention is directed to pre-treatment compositions for shoes. Applicants fail to find any teaching, suggestion, or inherency in Buzzaccarini of pre-treating compositions for shoes wherein removal of soil from the shoes in washings subsequent to application of the pre-treating composition to the shoes is improved over removal of soil from the shoes in

washings without application of the pre-treating composition to the shoes. The completely disparate purpose of Buzzaccarini, therefore, cannot supply the necessary motivation.

Moreover, the Examiner fails to make a §103 rejection of instant independent claim in addition to the § 102 rejection grounds already traversed and overcome. For this reason, in addition to the lack of teachings and suggestions in the sole reference discussed above, the dependent claims are nonobvious as well and the §103 rejection of claims 12, 28-29 and 31 under Buzzaccarini is overcome. Reconsideration is respectfully requested.

It is believed that the above represents a complete response to the rejection of claims 1-12 and 28-31 under 35 U.S.C. §§ 102 and 103 set forth in the Official Action mailed September 3, 2003 and places the application in condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,

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